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10/770,382

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Marcel Patek

FRAV2003/0002 US NP

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07/26/2007

ROSS J. OEHLER

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EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

07/26/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/770,382

Applicant(s)

PATEK ET AL.

Examiner

Deepak Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62, 64 and 76 ~~is/are~~ are pending in the application.
- 4a) Of the above claim(s) 10, 11, 51, 59 and 60 ~~is/are~~ are withdrawn from consideration.
- 5) ☒ Claim(s) 61 ~~is/are~~ allowed.
- 6) ☒ Claim(s) 8 ~~is/are~~ rejected.
- 7) ☒ Claim(s) 1-7, 9, 12-50, 52-58, 62, 64 and 76 ~~is/are~~ are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20070420.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to the amendment filed on April 20, 2007.

Claims 1-62, 64 and 76 are pending in this application.

Election/Restrictions

The instant application is under examination in view of elected invention of Group I, claims 1-9, 12-50, 52-58, 61-62, 64 and 76, drawn to compounds of formula (I) wherein p is 0 and R2 and R3 are independent substituents and are NOT taken together to form a cyclic group. Claims 10-11, 51 and 59-60 and claims 1-9, 12-50, 52-58, 61-62, 64 and 76 (all in part, wherein p is 1 or 2 and/or R2 and R3 together form a cyclic group), are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim.

This application contains claims 10-11, 51 and 59-60 and claims 1-9, 12-50, 52-58, 61-62, 64 and 76 (all in part, i.e., wherein p is 1 or 2 and/or R2 and R3 together form a cyclic group) drawn to an invention nonelected with traverse in the reply filed on August 18, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Withdrawn Rejections/Objections:

Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

The following rejections are necessitated by the amendment:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8 is drawn to a compound of formula (I) and the scope of the claimed compounds is beyond that is positively described for formula (I) in the original disclosure. As per the original disclosure as filed, the invention was described as being related to compounds of formula (I) (as described in pages 5-7), with the proviso that:

- a) when p is 0, R and R1 are oxygen, A1 is single bond or alkyl, Y and Y1, which may be identical or different, are at least one is -OCF₃ or -S-alk, A2 is single bond or alkyl and B2 is an optionally substituted heterocyclyl, then R2 and R3 are not one hydrogen and the other imidazolylalkyl;
- b) when p is 0, R and R1 are oxygen, A1 is single bond or alkyl, Y and Y1, which may be identical or different, are at least one is -OCF₃, -SO-Alk, -S(O)₂-alk or -SO₂NH₂, A2 is CH₂ and B2 is an optionally substituted heterocyclyl, then R2 and R3 are not one hydrogen and the other alkyl optionally interrupted with O, S or ; always substituted with a hydroxamate (-CO-NHOH);
- c) when p is 0, R and R1 are oxygen, A1 is a single bond or alkyl, Y and Y1, which may be identical or different, are at least one is -S(O)_n-alk, A2 is single bond and B2 is an optionally substituted 5- or 6-membered aromatic heterocyclyl, then R2 and R3 are not selected from the group consisting of hydrogen, alkyl, arylalkyl, aryl and heteroaryl; or
- d) when p is 0 to 2, R and R1 are oxygen, A1 is single bond, Y and Y1, which may be identical or different, are one is -SO₂Alk or SO₂NH₂ and the other is NR₅R₆, A2 is single

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bond or alkylene and B2 is optionally substituted 5- to 10-membered heterocyclyl, then R2 and R3 are not both hydrogen.

The instant claim does not contain the above proviso and therefore includes compounds that fall outside the scope of above conditions.

Allowable Subject Matter

Claim 61 is allowed. (*Note:* In the previous office action it was indicated that claim 62 is allowed. This was due to an inadvertent typographical error and it was intended to state that 'claim 61 is allowed'. Claim 62 was included in the rejections and was present as a rejected claim in PTO-326).

Claims 1-7, 9, 12-50, 52-58, 62, 64 and 76 are objected to for containing nonelected subject matter, but would be allowable if amended to the extent readable on the elected invention, i.e., p is 0 and R2 and R3 are independent substituents and are NOT taken together to form a cyclic group.

Receipt is acknowledged of the Information Disclosure Statement filed on April 20, 2007 and a copy is enclosed herewith.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


/Deepak Rao/
Primary Examiner
Art Unit 1624

July 11, 2007